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Trademarks

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THE S I S .

Characteristics
of the
T R A D E M A R K S ,

by

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THESES.

"Trademarks."

In dealing with the symbols and marks of Commerce as they are at the present time understood, we will omit the historic development of the same so far as practicable from the present writing, but suffice it to say that from the age of cultivators or when men manufactured other than for their own immediate use and sold the surplus in open market, or bartered among themselves, when Commerce and Civilization first took a progressive step, and the commodities of one country were exchanged for those of another, when men of different nationalities mingled, the badge of confidence between them in their dealings, was the symbol of the manufacturer, his commercial signature, and a guarantee to all those who bought his wares or goods stamped with his mark that the same were of his own manufacture.

A perfect system of trademarks is ascribed by Jobard to the Chinese; they excel in this institution of commercial guaranty, i. e., nearly all goods exported from China are hermetically sealed and fastened with paper bands having upon them the marks of the makers who thereby become responsible for the con-

tents of the package bearing their name or mark. Among the earliest legislation on the subject is that of the Tribunal of Geneva (1759) and holding that the mark of a manufacturer when used as a trademark is property under the law of nations, and other nations by their judicial decisions have repeatedly held the same. The Tribunal of Brussels affirmed the same doctrine and going farther in holding that a domiciled alien could pursue an infringer in any court, even if there be no treaty between the countries at the time the suit is brought, the claim being based upon natural justice.

This comity among the nations is distinctively recognized in the United States; see the case in 45 Cal. 479, where the judge lays down the following propositions: First. That because a symbol has been used in the United States for any article by anyone prior to its claimed adaptation in the United States by a claimant, it cannot be a trademark provided it has been in common use for similar purposes and articles to those in question outside of the United States. Second. That if a claimed Trade Mark for an article cannot be maintained in the country where the article is made it cannot be elsewhere, i. e., the jurisdiction of one country does not extend to such an extent to make void acts valid and vice versa.

Regarding the first of these propositions it is correct to say that there is no exclusive ownership of the symbols which constitute a trademark apart from the application of them to a specific article. But the word trademark is the designation of those marks and symbols when applied to a vendible commodity and the exclusive right to make such uses on application is rightly called property; the true principle is therefore that the jurisdiction of the courts in the protection of trademarks rests upon property and the court interferes by the injunction because that is the only mode by which property of this description can be effectively protected. The symbol or mark need not be attached to the goods themselves, it oftentimes being that the goods are incapable of it; an instance of this would be in the sale of liquors when to attach a symbol to the goods to be sold would be a physical impossibility and the mark in such cases may be attached to the bottles or the cork when put in the bottles and these are valid trademarks with the limitation that if the goods are capable of receiving the mark it must be put upon them direct, but if otherwise then to the conveyance containing them, the primary object being that the mark accompany the goods when on sale.

Although the manufacturer may have the exclusive ownership of the symbol when applied to a certain vendible commodity

it does not follow that this is an absolute right, that is to say, if the manufacturer of carriages adopt a fanciful mark, to donate the make of the same and establish a reputation and demand for their superior workmanship and durability that fact would not prevent the manufacturer of woollen goods from applying the same mark to such goods. There must be regards not merely to the mark but the nature of the goods upon which the mark is impressed.

No person who is in law capable of acquiring property of any species, is excluded from the acquisition of property in trademarks. There is no special time prescribed for one to obtain the control of a symbol in connection with his goods, but the rule seems to be: That the moment one who has selected a fanciful symbol to indicate his merchandise and applies the mark to his goods the act is complete. The avowal of his intention to adopt, his registration of the mark, and notice to the whole world does not constitute adoption, but apply the mark to the article on sale and eo instanti the act is complete. There seems to be one limitation on all persons acquiring property in a trademark and that is that they must be engaged in a trade or mercantile business and even then it is not acquired by the mere act of selecting but by a union of the abstract

representation of the object with a vendible commodity, the inclosure right becomes perfect and title rests in the appropriator be he citizen or alien, if the business conducted be lawful and with sincerity. The maxim *maximi vigilantibus non dormientibus leges subveniunt* is not always the doctrine for not only the watchful but the careless should be protected, the buyer as well as the manufacturer, and the rule of *Caveat Emptor* should be changed into *Caveat Venditor* demanding sincerity in the seller rather than extreme caution in the purchaser.

James J. in 57 Bart 586 says the doctrine of protection to Trademarks is now well established. The principle which underlies the doctrine is that he who by his skill, industry, and enterprise has produced or brought into market or service some commodity or article of use, convenience, utility, or accommodation and affixes to it a fanciful name, mark, or device or symbol which serves to designate it as his is entitled to be protected in that designation, from encroachment so that he may have the benefit of his skill, industry, or enterprise and the public be protected from the hand of imitators.

But the mere imposition on the public occasioned by one man selling his goods as the goods ~~as the goods~~ of another cannot be the grounds of a private action; the mere fraud on the public will not induce the Chancellor to interfere unless the

Plaintiff has sustained or has reason to believe he will sustain pecuniary loss. Imposition on the public becomes the test of the property in the trademark having become invaded but it is not the ground on which the court rests its jurisdiction.

Whatever be the protection offered to the manufacturer for his goods and wares whether it be under a Statute authorizing the registration of trademarks and compelling those who intend to trade or sell their commodities to put thereon a symbol recognized and protected by the country of which he is a citizen, or in the absence of statute and Registration laws to have recourse back on the usage and custom of merchants in their unorganized though firmly established association, for the mutual protection of themselves, and it follows that whoever weakens such confidence by forging, counterfeiting or other frauds and begets and fastens distrust in the commercial world, is an enemy of mankind. He becomes a pirate and whether preying on the seas or on the land and under the cover of respectability he is to be regarded as a common foe; of little practical value would the laws of a single country afford, when its jurisdiction is restrained within well defined boundaries, against the misrepresentation of the citizen of another country in their commercial relations, were it not for the Comity of the nations,

an unwritten law so firmly established as to be regarded a rule of international law with power and authority to protect all, whether it be citizen or alien, and he who expects to manufacture and sell his goods outside his own country must recognize and follow such law, protection fosters confidence and trade is founded in mutual reliance and confidence one with the other, thus millions of dollars are transferred by a symbol, or name. An armed neutrality must be maintained; once allow distrust to block the arteries of commerce and no man trust the representative of another, and the golden age will cease, and the earth will lapse back to the age of hunters. Or, as Monsin Jobard states the proposition: the age of shepherds follow the age of hunters; the age of cultivators that of shepherds, and we are in the industrial age reaping the benefits of the experience and inventions of others bound together by those aims of commerce, the Railroad and telegraph, with daily intercourse from all parts of the world. These and other illustrations of the throwing aside of animosity and distrust, and establishing a confidence based on self-protection, the arch, of which is commerce and the keystone, the trademark, recognized through all civilized countries and protected by a multitude of laws but with a sameness withall and evidence of the theory "That what

should be done will be done" substantially the doctrine of the natural law of Grotius.

The physiology of the thing called a trademark must be examined and carefully analyzed. It has an individual nature, meaningless in itself, but when placed in a certain locality and condition it evolves the idea. It virtually says that the vendible commodity or object to which it is attached is the workmanship or selected article of the owner of the mark. It is intended to strike the eye by its clearly defined character, or the ear by the sound when spoken, it must be peculiar in form although possibly not susceptible of utterance or sound but its meaning, purpose and value are well known to all manufacturing and commercial people. That it requires no definition in a treaty whose every word is subject to the closest scrutiny, though they are mainly compacts of reciprocity, of protection, and do not give vitality to the thing.

To examine the characteristics and essential features of a trademark as given by Brown in Trade Marks (pg 240) they are as follows:

- (1) Invariability viz: fixed, positive, unmistakeable.
- (2) Individuality, such a difference from other symbols as to indicate the origin and ownership.

- (3) Universality of a right to use good as a representative of or a substitute for the owners signature all the world over.
- (4) Exclusiveness or the right to use.
- (5) Application to merchandise.
- (6) Use in lawful business.
- (7) Trust and good faith.
- (8) Duration unlimited, but by the trade itself; protection may however sooner cease.

Realizing the almost impossibility of setting forth a clear and comprehensive definition of the term, and as Upton says almost undefinable but giving the following:

It is distinctively manifest that as much as any other property a right to a distinctive mark of authenticity has its foundation in immutable law and an arbitrary law as a treaty Statute and etc. cannot be the parent of this ~~idiographic~~ sign. The right preexisting, a compact only recognizes that right and opens the door to the remedy thereon. "The mark may consist of the name of the Manufacturer or merchant provided it be written or printed, branded or stamped in a mode peculiar to itself, or a seal letter, cipher, monogram, or any other sign or symbol that can serve to distinguish the products of one man from those of another. It may be an emblem or symbol, however

unmeaning in itself, provided it be not descriptive, or it may consist of a combination of various objects copied from nature, art or fancy and if such symbol or emblem comes by use to be recognized in trade as a mark of a particular person or persons and be affixed to a certain class of goods, no other person or persons may use the same on a similar class of goods.

A Trade Mark must therefore be distinctively in its original signification pointing to the origin of the article, or it must become so by association. A purchaser feels sure that he is getting the genuine article when the same device or emblem is affixed to the article being bought as was previously affixed to the genuine article, but the difficulty is, what does distinctively indicate the genuineness or original ownership, this can only be determined by an examination of the several cases. What indicates the ownership in one does not conclusively do so in another and it follows that each must stand on its own peculiar surroundings. Any simple device may be associated with the person and convey the information desired or even the name of the proprietor. Associations are called up at the sound of the word or an impression is left on the vision of the beholder. The purchaser buys with seeming carelessness not always keenly scrutinizing the various indicia of genuine-

ness, its origin is clearly indicated, the true test is confidence. The symbol satisfies him that the article on which it may be is genuine. Good faith is the bond of commerce; without it doubt and hesitation will fetter enterprise and restrain commerce. Two articles may be the same in outward appearance; the same color, size, weight; the purchaser has no guide to assist his judgement except the reputation of a certain manufacturer, he discovers his mark of authenticity and guaranty; he is satisfied and buys. A Trade Mark is nothing more nor less than one's commercial signature on his goods; and the mark and the goods bear the same relation to each other as do the positive and negative forces of electricity. In their application they mutually sustain and uphold each other.

But we must be cautious to discern between things whose natures differ and assign to each its appropriate and peculiar sign, by words which fit close to the thoughts in the mind, otherwise we will be confused by the jumble of the marks of commerce. A definition would instantly convey the precise species of a genus. A trademark is in its nature, separate and distinct from everything else in the world and must be used in the exact way the word signifies. Astrology and Astronomy were anciently used interchangeably yet the terms would not be

confounded. At the present day, and before the nice distinction regarding trademarks was understood, learned jurists made use of the terms trademark and label as though synonymous terms. But now the particular symbols of commerce must be carefully distinguished from its analogies. We must be exact in specifying the name of any kind of legal right to obtain the legal remedy. Generic terms must be avoided, as for instance in a statute against horse stealing we must not use the term horse and animal as convertible terms. We must say exactly what we mean. The question is: if labels are not technical trademarks why permit evidence of their contents to be introduced? For this reason. Although labels are not constitutional elements of trademarks and are but vehicles for the same, all the details must be proved by the surrounding facts circumstantiati and should be brought forward as witnesses of fraudulent intention and therefore the introduction of the label. Anyone may lawfully copy an emblem of personality and may publish it to the world, but if in addition to the act of imitating, he uses it in a peculiar manner as to obtain false credit, by applying it to merchandise for sale, then his intent may be inferred from all minor acts. We know that mere labels, notices, business cards etc. possess none of the characteristics of trademarks and are not therefore entitled to registration for the reason

that they are not technical trademarks of commerce and are descriptive and generic in character. The words of the label would not have that magical effect of transmitting the label into a thing of another nature. It is not therefore an arbitrary symbol but a true description of what the article really is and generic in its interpretation as for instance the word valve jars when applied to jars hermetically sealed by the use of a valve attached to the jars.

Generic names, or names merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, are not valid trademarks. This is the general doctrine but it has its exceptions; under the general rule, courts will refuse protection to claims for exclusive right of use in names of a vendable commodity, and which others must use in the necessary description of the goods, and when the name is properly common to all, the supposed trademark is simply a label and not subject to protection. The primary object of the mark being to designate the origin or ownership. But the fact that the particular article has attained such a wide reputation and sale that the mark indicates the quality rather than the manfr . To hold such to be of common ownership would be to deprive the owner of the exclusive use of his mark at the time when it has become the most valuable, and though the mark to some extent denotes

quality, this will not disentitle the manufacturer of protection. But the line of demarcation is not so easily drawn. An illustration would be the word Worcestershire at first used as a valid trademark, but by tacit abandonment it became common property, it is also the name of a city of local manufacturing and had been used by others in the same occupation and finally the United States courts decided it to be generic in character.

There are few cases in the law so difficult to reconcile as those pertaining to the validity of a trademark.

2. OF WHAT MAY A TRADE MARK CONSIST?

In a general way this may be answered in that any arbitrary symbol not descriptive of the article to which it may be attached may be a trademark. To what extent will a person's name be protected as such, and to this there are different phases of looking at the matter. Clearly the name "John Brown" could not be a trademark to exclude all others from the use thereof. It would be against public policy, but the addition of some other word, though the whole be generic in character, yet the combination may entitle it as a trademark. An illustration of this would be, John Brown pain killer, the decisions on this point are far from uniform. But one may use his own

name as the name of another if he put it in the way of an autograph; it is then the emblem or symbol of himself and not merely his name, but if another should have the same name and autograph the property in the mark would then be a question for the jury. The similarity may be fortuitous and without fraudulent intent and unless a man adapt a flourish or peculiar mark in connection with his name he had better not use it as a symbol. Allusive devices although suggestive of the name would not on that account be refused as valid trademarks, as for instance the symbol of sea shells affixed to an article as the mark of one named Shelly.

An encroachment upon the good will of a business when such good will is in part the firm name is sometimes the essence of the wrong involved with the violation of the trademark: the good will of a business as defined by Story is the advantage and benefit which is acquired by an establishment beyond the mere value of the capital stock, funds or profits belonging to them in consequence of the general public patronage which is received from a constant or habitual customer, or on account of its local position or common celebrity, reputation or skill or through affluence, accidental circumstances or prejudice and from this definition and cases it may be seen that the name of

a firm may be a trademark though not made in the form of an autograph. Or, as the court says in 1 Johns 176 The name of a firm is a very important part of the good-will of the business carried on by that firm. This is more readily seen when not a single member of the individual name exposed as the firm are in fact part of the same and in Compen v. Bajou, Paris Appeals Cases. When Bajou assigned to defendant Morel, for a price agreed upon, the fabrications and accessories of glove manufacturing, but also the good-will of the business, and for that purpose the stamp employed by him and being the fac-simile of his signature. Morel assigned to Compere and Bajou recommenced business and advertised the fact adopting the same mark as before used as his trademark. Injunction was obtained and sustained. The court holding that the good-will of the business passed marks of the Defd. and that his signature as so used was such a mark. The above case goes farther than most cases, but it is true that a name or style of a firm may by long use become a trademark and cease to convey any representation as to the fact of the person who makes or the place of manufacture. But when any symbol or label claimed as a mark is so construed or worded as to make it contain a distinct assertion which is false, or if the manufacturer has acquired by his per-

sonal skill and ability a reputation which gives to his works in the market a higher value than those of other artisans, he cannot give to any other person the right to affix his name or mark to the goods, and to sell; an article so stamped with a false representation is pro tanto an imposition on the public.

A package in which a commodity be put if made in a queer and novel manner though not strictly a trademark yet in some cases when another has so copied that it clearly appears there is an intention to defraud, the courts will grant the injunction as in 4 Fed. Rep. 527. The court says: The complainant alleges that to individualize and indentify his pencils he adopted a peculiar and original mode of packing, and also set forth that his method of packing, including the size, shape and color of his large packages were original with him and have never been varied, and that all the leading characteristics as above set forth have been imitated by the Defa. The line of defense being that there was not a technical trademark in the case. The Court says, what we decide is, that whether the complainant had a trademark or not, he was the first to pack in such labelled boxes, and as his goods have become known to the purchasers and are bought by reason of such peculiar shape, color and size, no person has the right to use the complainant's form of packing.

in imitation thereof and in 6 American Law Review the plaintiffs whiskey manufacturers, sold their product in peculiar barrels and claimed a trademark on the same irrespective of the brands on it. Sawyer J. says he found no case where the package of peculiar form and dimensions had been restrained. But a harder question is presented when the design or symbol is made to sell to other manufacturersthe whole value of the label depends upon the peculiar configuration and he who buys the label thereby obtains a license to sell that particular kind of goods, and at the same time he was furnished with a certificate of good workmanship. That was intended to be sold, the label surely. But the label would have been incomplete without a peculiar mark, and then that peculiar mark could not be considered to be a trademark strictly speaking, for a trademark is merely an index index to something else, but if it actually entered into and became an essential component part of the commodity it answered the requirements as to design. A matter of configuration of a new and useful article of manufacture--and without the peculiar mark it would not have served its destined purpose, and such a label has been decided to be a design. And for a symbol to be a technical trademark, there must be some word or device other than the genuine name and words descriptive of quality and terms in common use to designate a trade or occupation in

connection with these words indicating that a peculiar class of merchandise of the same general description is specially dealt in, cannot be exclusively appropriated as a trademark. With regard to geographical names being used as to trademarks, the case in 15 Abb. P. Rep. 302 states the rule as generally understood and accepted by text-book writers. This was the case to restrain the defendant from the use of the word "Worcestershire" as applying to a certain brand of sauce. The Court says the defendant doubtless might, under proper circumstances employ the name of the place where the article is manufactured, as well as the word descriptive of its character, but such words must be employed honestly and properly, and not with design to deceive and imitate, to the detriment of others. When names are in common use, no person can claim a special appropriation of them to his own particular use; but when words or collections of words have by language become known as designating the article of a particular manufacturer, he acquires a right to them as a trademark which competing dealers cannot fraudulently invade. It is quite immaterial whether the term was generic at the time of its adoption by the claimant, or whether since it has become so by constant usage or otherwise. In either event the result is attained viz: generic character and

the general rule that a geographical name of a place cannot be used or taken by anyone exclusive has been well settled since the case of 13 Wall. 311. But the exception to said rule may be said to be FIRST when the term ceases to be geographical in meaning, and becomes a mere fancy name in reality or in the general estimate or view of the public. SECOND. When the claimants own all the land of the place from whence comes the article, whether manufactured or natural. See 57 Barb. 526

Another class exists spoken of but as it would often seen erroneously as trademarks as when a geographical name has been so long associated and used with the article that its original geographical meaning has been reduced to a secondary signification. When used in connection with the article to be protected, and in general estimate has become merged into the name of the article as the famous Weatherspoon and Curry ^{case.} A picture, though eminently suggestive of the character of the goods, if it be not descriptive or geographical in character, if done in fancy colors or peculiar to a certain degree, may be a valid trademark.

Color may be an essential feature in the groundwork of a symbol but it would be an unwise policy to adopt an arbitrary color for the reason that an injunction would not lie if another design be made bona fide and an entirely different color used. For this reason the delineation of the emblem is relied upon

rather than the chromatic effect. But among all the untrustworthy trademarks are mere numerals, and by any combination of them, how can the manufacturer look for protection. They are in every day use when put on goods, as trademarks they are meaningless, except as a symbol. An examination of the cases lead us to the conclusion that symbols or figures do not of themselves indicate any appropriate name of the article or any mode or process by which it is manufactured. They do not indicate the quality of the article, but if connected with the owners name or otherwise they indicate the origin of the ownership of the article. This in connection with the words impressed on the article to designate the pattern as distinguished from other articles of his own manufacturing, and also to distinguish it from others of other manufacturers. The numerals and other words not descriptive, seem to be within the rule that allows a device to become a trademark. But numerals standing alone, if arranged in a peculiar manner, as if in imitation of Chinese letters, or placed over each other, there then can be no doubt as to their right of protection, and letters are substantially on the same basis.

Symbols borrowed from the Mediaeval heraldry of Europe may be used, though liable to be set aside in a foreign court.

And to reiterate briefly. In a technical trademark case since the right of protection is founded on the sole right of the application to, or the right of property in a trademark a liability to deception need not be proved. A technical trademark is the sole right of application against the whole world, but which cannot exist if it comes under the head of unfair competition in business. The vital point in such cases is to determine whether or not the claimed trademark where applied to the article in question is understood in common public parlance as a fancy name, or still where so applied partakes of its original geographical or other name and meaning. In the first it is a trademark case; in the second, an unfair competition in business.

3. WHEREIN A TRADEMARK DIFFERS FROM A PATENT ETC.

A trademark is not an invention or discovery within the meaning of the clause of the Constitution empowering Congress to secure to authors and inventors the exclusive right to their inventions and discoveries. As the right and property of a trademark attach at Common Law and are not dependent on any Statute or act of Congress for their maintenance and enforcement, and this they differ from the patent and copyright priv-

illeges, which are creatures of statute and regulated by Congress. The power given to Congress to promote the progress of science and useful arts is restricted to authors and inventors and the power of protection thus given can only be for a limited time. When the protection is removed and the invention or discovery or copyright is thrown upon the world and all persons may make and imitate the article in all its essential features, and dispose of the same in any legitimate manner, and may even specify that it is the same article manufactured by the rival manufacturer and on which the patent has expired. But in whatever way they may imitate the article itself, if the manufacturer has used in connection with that particular class of goods, a symbol or arbitrary mark, and has so continued to use such mark, he will be protected as against all the world, which protection will not expire with the patent by lapse of time, but limited only by the period of its use and ceases only with its abandonment. While the protection on a patent lasts, the property in it is perfect. It may lie dormant throughout the whole of the prescribed period, or be used a time and thrown aside, but the property remains the same, while in the trademark there must be a continuous use and application.

The exclusive right of multiplying copies of original

production of the mind, whether in the form of books, maps, engravings, designs, or others of a manifold emanations of human thought expressed by words or symbols bears no appreciable resemblance to the right of property in a mere name, figure, mark, device or symbol where used as the designation of the thing.

In the first it is the article itself that is protected; in the second it is the sign, figure, or symbol affixed to the article of commerce. But a word as to the meaning of word "representation" as herein used. If there is a distinct and obvious trademark showing the goods in question are manufactured by he who sells them, it is evidence of his bona fides. Again if he tells the purchaser in plain English that the goods however described, are his own manufacture, and not use small type for one statement and large for another, and openly and fairly states the circumstances, then it is a strong indication that he did not intend to deceive. And if he knows that they are not the goods^{of the person} entitled to the trademark and communicates that knowledge to the immediate purchaser, it will, nevertheless be fraud, as the immediate purchaser from him is aware that the goods are not his manufacture--and as he passes them along the representation does not necessarily follow them, and the ulti-

mate purchaser would be as much deceived as if no such communication had taken place.

A Trade Mark patent is a term frequently used to indicate the certificates given by the government; but it is illogical and mischevious word. As the mark is not granted by the government and should the certificate be proved to be informal and worthless, that fact would not invalidate the trademark, but would simply prevent the person from using the certificate as convenient evidence that such a mark did in fact exist, and not require him to go back of registration to prove long usage. So the erroneous use of the word patent, when trademark is meant admits what is not true, that the government has conferred a right which may expire, whereas the symbol exists Ex proprio vigore by virtue of the immutable law. But if the word patent is ignorantly misapplied, the legal consequence may be to deprive the owner of the mark of redress for the violation thereof.

A. B. COLE.

